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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/613,605 | 07/03/2003 | David DeRogatis | RAILWA 3.0-001 | 7300 |
| 23562 | 7590 | 12/20/2005 | EXAMINER | |
| BAKER & MCKENZIE PATENT DEPARTMENT 2001 ROSS AVENUE SUITE 2300 DALLAS, TX 75201 | | | GARCIA, ERNESTO | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3679 | |

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/613,605 | Applicant(s) DEROGATIS ET AL. | |
| | Examiner Ernesto Garcia | Art Unit 3679 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005 and 02 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,6-8,11-18 and 21-49 is/are pending in the application.
- 4a) Of the above claim(s) 6,12,14-18 and 21-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7,8,11,13 and 49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 and 13 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/03/2005 has been entered.

Election and Restriction

Claims 6, 12, 14-18, and 21-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on May 13, 2005.

Drawings

The remarks filed on September 2, 2005 indicate that replacement drawings were filed; however, no drawing replacement sheets were filed with the amendment filed on 9/2/05. Therefore, the objects are still pending and made relative to the replacement sheets filed on 5/13/05 and 2/4/2004.

The drawings received on May 13, 2005. These drawings are not acceptable.

The drawings filed May 13, 2005 do not comply with 37 CFR 1.121 as the drawings sheets were not label as "Replacement Sheet". Note, that the current label "Replacement Drawing" is not an option under rule 1.121. Further, any replacement sheet of drawings shall include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is amended. Therefore, the sheet having Figure 15A does not include Figures 16 and 17. Further, Figure 15B is not a proper cross-section of Figure 15A as the plug fastener in Figure 15A has an square aperture for a tool and Figure 15B is another species having an aperture for a screw. Further, the reference to 15B-15B in Figure 15A needs to be deleted. If applicant wants to submit the two new sheets, than the drawings sheets of record need to be cancelled and the added sheets needs to be labeled as "New Sheets".

The drawings are objected to because the plane 1-1 in Figure 2 needs to be deleted since Figure 1 is not a cross-sectional view of Figure 2.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: the use of reference character "212A, 212B, 214A, 214B", on paragraph 055, to describe also a

surface is not consistent with the drawings. According to elected species, these characters define portions of the plug fastener. Further, the use of a "first engaging surface" and a "mating surface" to describe these portions is inaccurate because a sphere has been established to have one spherical surface only. Therefore, how can there be two surfaces, i.e., a first engaging surface and a mating surface in a sphere? The examiner suggests that the terms --first engaging surface portion-- and --mating surface portion-- be used as alternative descriptions to better define the elected species. Appropriate correction is required.

Claim Objections

Claims 7 and 49 are objected to because the following informalities:

regarding claim 7, "and" in line 1 should be deleted; and,

regarding claim 49, "deformable" in lines 2, 3, and 5 should be deleted.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

Claim Rejections - 35 USC § 112

Claims 1, 3, 7, 8, 11, 13, and 49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the limitation "first engaging surface" in line 3 and "mating surface" in line 5 to define a spherical surface of the elected species is inaccurate and misleading. Since the plug fastener is spherical and it has been established that a sphere has one spherical surface, how can there be two surfaces, i.e., a first engaging surface and a mating surface, in a sphere?

Regarding claims 8 and 13, it is unclear how the shape of a cylindrical, ellipsoidal, elliptic conical frustum, and pyramidal frustum are alternative expressions of the group of spherical shapes, or equivalents in the art.

Regarding claims 3, 7, 8, 11, 13, and 49, the claims depend from claim 1 and therefore are indefinite.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 8 be found allowable, claim 13 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

Claims 1, 3, 7, 8, 11, 13 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by McClain III, 5,164,538, (see marked-up attachment).

Regarding claim 1, McClain III discloses, in Figure 4A, a plug fastener comprising a first engaging surface **A1** and a mating surface **A3**. The first engaging surface **A1** has first ridges **A2**. The mating surface **A3** has an second ridges **A4**. The first ridges **A2** are slanted towards the second ridges **A4**

Applicants are reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the first ridges can be adapted to frictionally engage an interior surface of an opening in a picket and the second ridges can be adapted to frictionally engage

with an interior surface of a second article. Further, it is inherent that frictional engagement of the first engaging surface and the mating surface will be sufficient to fixedly connect the picket to the second article.

Regarding claim 3, applicants are reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, the plug fastener can be adapted to connect a picket at an acute angle or a right angle to a second article.

Regarding claim 7, at least one of the first ridges **A1** or the second ridges **A3** comprises an angled top surface **A5**. The angled top surface providing the slant of the first ridges **A2** or the second ridges **A3**.

Regarding claims 8 and 13, the first engaging surface **A1** has a shape selected from a group consisting spheroidal, cylindrical, ellipsoidal, conical, elliptic conical frustum, pyramidal frustum, and ball.

Regarding claim 11, the first ridges **A1** and the second ridges **A3** are deformable ridges. Applicants are reminded that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ

138. Therefore, the deformable ridges can be adapted to frictionally engage the opening in the second article when deformed.

Regarding claim 49, at least one of the first ridges A2 is slanted in a direction opposite than a direction of at least one of the second ridges A4. At least one of the second ridges A4 is slanted in a direction opposite than at least one of the first ridges A2.

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 7, 8, 11, 13, and 49 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rudy, 3,013,244, White, 892,105, Reniau, 6,739,786, and Jones, 6,889,960 show a similar plug fastener.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 571-272-

7083. The examiner can normally be reached from 9:30-5:30. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached at 571-272-7087.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

E.G.



E.G.

December 4, 2005

Attachment: one marked-up page of McClain III, 5,164,538

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Art Unit: 3679

McClain III, 5,164,538

